

**REMARKS**

Applicants are amending their claims by adding new claim 87 to the application. Claim 87, dependent on claim 10, recites that the epoxy resin having a biphenyl structure in the molecule is a biphenyl epoxy resin. Note, for example, from page 12, line 31 through page 14, line 12, of Applicants' specification.

Applicants respectfully traverse the withdrawal of new claim 85 from consideration on the merits in the above-identified application, set forth in Item 2 on page 2 of the Office Action mailed May 22, 2008. Thus, the Examiner states that claim 85 is directed to a phenol-modified cyanate ester oligomer derived from the reaction of a cyanate ester and a monovalent phenol in the presence of a polyphenylene ether, contending that this claim is equivalent to claim 43 of the non-elected invention of Group X set forth in the Office Action mailed October 11, 2007. Note that claim 85 recites a resin composition for printed wiring board and is dependent on claim 10, being considered on the merits in the above-identified application, and thus includes the epoxy resin containing at least one kind of an epoxy resin having a biphenyl structure in the molecule as in claim 10, in addition to other components. Note that the Examiner has indicated that Group V, the elected group, includes, inter alia, a biphenyl epoxy resin, thus included in claim 85; and that the Examiner does not refer to a biphenyl epoxy resin in connection with claim 43, the Group X claim withdrawn from consideration. As claim 85 includes an epoxy resin having a biphenyl structure in the molecule, not referred to in the Group X claim 43, basis for the contention by the Examiner that claim 85 falls within the non-elected invention of Group X is not understood, and is respectfully traversed.

To the contrary, it is respectfully submitted that new claim 85, dependent on claim 10, falls within the elected invention of Group V in the Office Action mailed

October 11, 2007, and should be included in the claims being considered on the merits in the above-identified application.

In view of the foregoing, reconsideration of withdrawal of claim 85, and consideration of claim 85 on the merits in the above-identified application, are respectfully requested.

The rejection of claims 10 and 50-55 under 35 USC 103(a) "as being unpatentable over Mizuno et al. Patent No. 7,157,506", set forth on page 3 of the Office Action mailed May 22, 2008, is respectfully traversed, in view of the following.

Thus, note that U.S. Patent No. 7,157,506 has a publication date of January 2, 2007, after the effective filing date of the above-identified application (September 29, 2003, the filing date of the corresponding International (PCT) Application No. PCT/JP03/12399).

In addition, the following is hereby stated by the undersigned:

**The above-identified application and U.S. Patent No. 7,157,506 were, at the time the invention of the above-identified application was made, owned by Hitachi Chemical Co., Ltd.**

In view of the foregoing, it is respectfully submitted that U.S. Patent No. 7,157,506 is disqualified as prior art under 35 USC 103(a). See 35 USC 103(c). For this reason alone, it is respectfully submitted that the rejection over U.S. Patent No. 7,157,506 must fail.

The Examiner's attention is respectfully directed to the publication date of the application corresponding to U.S. Patent No. 7,157,506 (that is, U.S. Patent Application Publication No. 2003/0130412, published July 10, 2003. Also to be noted is the publication date of the International (PCT) application corresponding to No. 7,157,506 (that is, International (PCT) Publication No. WO 01/70885, published September 27, 2001). In any event, it is respectfully submitted that U.S. Patent

No. 7,157,506 is disqualified as prior art in connection with the presently claimed subject matter, such that the rejection in the Office Action mailed May 22, 2008 must fail on this basis alone.

It is noted that U.S. Patent No. 7,157,506 discloses a resin composition suitable for printed wiring boards for various purposes, describing a resin composition comprising a phenol-modified cyanate ester oligomer containing a polyphenylene ether resin, produced by reacting a cyanate compound (A) with a phenol compound (B) in the presence of a polyphenylene ether resin under specific conditions, further phenol compound (B), and an inorganic filler (F) surface-treated with a specified silicone polymer (D). See column 6, lines 6-30. This patent further discloses that the resin composition may be incorporated with a variety of resins or additives, e.g., flame-retardant (G), epoxy resin (H) or antioxidant (I) as required, within limits, not harmful to characteristics of the resin composition. See column 15, lines 38-44. The epoxy resin (H) which can be incorporated is described, for example, from column 16, line 56 to column 17, line 34.

It is respectfully submitted that the teachings of U.S. Patent No. 7,157,506 as a whole would have neither taught nor would have suggested such resin composition for printed wiring board as in the present claims, including unexpectedly better results achieved where such composition, including components as in the present claims, includes an epoxy resin containing at least one kind of an epoxy resin having a biphenyl structure in the molecule.

As to the unexpectedly better results achieved where the composition includes such epoxy resin having a biphenyl structure in the molecule, attention is respectfully directed to the disclosure in Applicants' specification at page 5, line 28 to page 8, line 4. As described therein, the composition with inclusion of the epoxy

resin containing a biphenyl structure has improved breaking strength and breaking elongation, with no crack during drilling treatment when used in a multi-layered printed wiring board. In addition, a drifting property at high temperature is also excellent; that is, dielectric characteristics due to a change in temperature vary little. Note especially the paragraph bridging pages 6 and 7, as well as the sole full paragraph on page 7 and the paragraph bridging pages 7 and 8, of Applicants' specification.

Attention is also respectfully directed to the experimental data in Applicants' disclosure. This experimental data must be considered in determining patentability of the presently claimed invention. See In re DeBlauwe, 222 USPQ 191 (CAFC 1984).

Note especially Tables 1, 3, 5 and 7 respectively on pages 48, 59, 70 and 81 of Applicants' specification, describing various Examples within the scope of the present claims, and Comparative Examples; and note the results in connection with each of these Examples and Comparative Examples, respectively in Tables 2, 4, 6 and 8 respectively on pages 51, 61, 73 and 83, of Applicants' specification. In this regard, note that Table 2 shows results achieved in connection with the compositions in Table 1; Table 4 shows results achieved with respect to compositions in Table 3; Table 6 shows results achieved in connection with compositions in Table 5; and Table 8 shows results achieved in connection with compositions in Table 7.

It is respectfully submitted that the Examples and Comparative Examples show unexpectedly better results achieved according to the present invention, utilizing an epoxy resin wherein such epoxy resin includes an epoxy resin containing a biphenyl structure in the molecule. As to the comparison examples in the Tables, note the discussion of results in Table 2, on page 52, lines 1-20 of Applicants'

specification. Note also the discussion of the results in Table 4, on page 62, lines 1-19, of Applicants' specification. See also the discussion of the results in Table 6, on page 74, lines 1-22, of Applicants' specification. And see a discussion concerning the results shown in Table 8, on page 84, lines 1-22, of Applicants' specification.

It is respectfully submitted that this evidence in Applicants' specification shown unexpectedly better results achieved by the presently claimed invention, containing, inter alia, the recited epoxy resin having a biphenyl structure in the molecule, supporting a conclusion of unobviousness of the presently claimed invention.

In view of the foregoing comments and amendments, reconsideration and examination of claim 85 on the merits in the above-identified application; and, of the claims then being considered on the merits herein, reconsideration and allowance of all such claims in due course, are respectfully requested.

To the extent necessary, Applicants hereby petition for an extension of time under 37 CFR 1.136. Kindly charge any shortage of fees due in connection with the filing of this paper, including any extension of time fees, to the Deposit Account of Antonelli, Terry, Stout & Kraus, LLP, Account No. 01-2135 (case 511.44961X00), and please credit any overpayments to such Deposit Account.

Respectfully submitted,

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